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10/595,615	05/01/2006	Paul Kenneth Rand	PB60533USW	3598
23347	7590	01/08/2009	EXAMINER	
GLAXOSMITHKLINE CORPORATE INTELLECTUAL PROPERTY, MAI B482 FIVE MOORE DR., PO BOX 13398 RESEARCH TRIANGLE PARK, NC 27709-3398			MOORER, CELENE NICOLE	
			ART UNIT	PAPER NUMBER
			4138	
			NOTIFICATION DATE	DELIVERY MODE
			01/08/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/595,615	Applicant(s) RAND, PAUL KENNETH	
	Examiner CELENE MOORER	Art Unit 4138	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/11/2006; 5/1/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it contains phrases that can be implied, i.e. "the present invention provides". Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: #139 in Figure 8. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing

Art Unit: 4138

date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 1-25 are objected to because of the following informalities: In claim 1, there is no clear transition, *e.g.* terminology such as "comprising" or "consisting of," between the preamble and the body of the claim. Currently, the phrase "defines a conveying path" is being considered as the body of the claim, and preceding portion of the claim is being considered as the preamble. Correction is required.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 7 recites the limitation "first side sections; second side section; first side portion" in the lines of the claim. There is insufficient antecedent basis in the specification for this limitation in the claim.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 7, lines 2-9, it is unclear as to what are the pair of first and second side sections within the path and what is the pair of opposed first

Art Unit: 4138

side portions that extend in the first direction, the at least one fold section being directed such that each side portion is facing relation with a different first side section. In claim 8, lines 1-2, it is unclear as to what are the first and second side sections.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

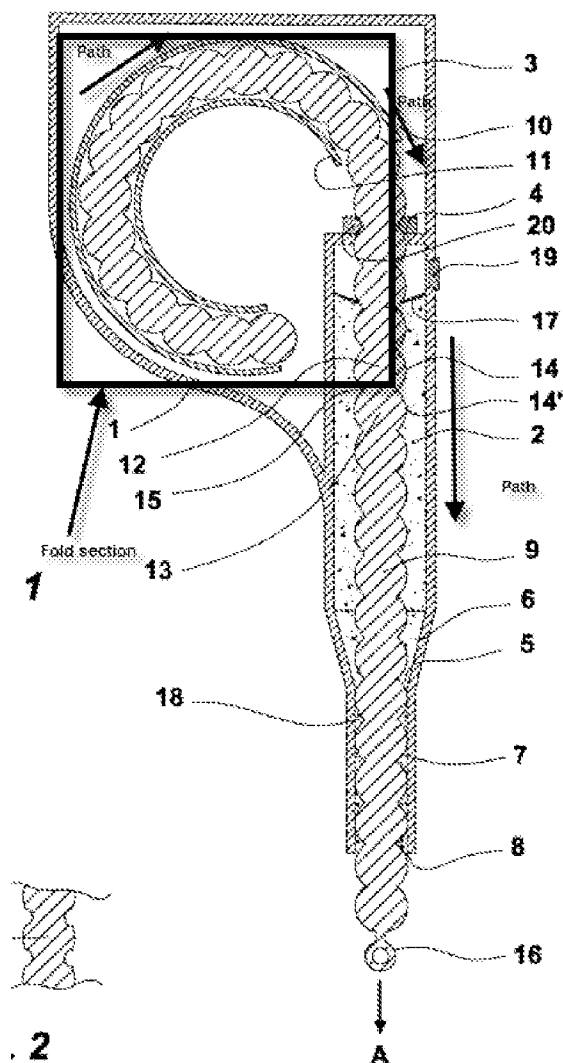
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6, 9, and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/28617 A1 to *Ewerlog et al.*

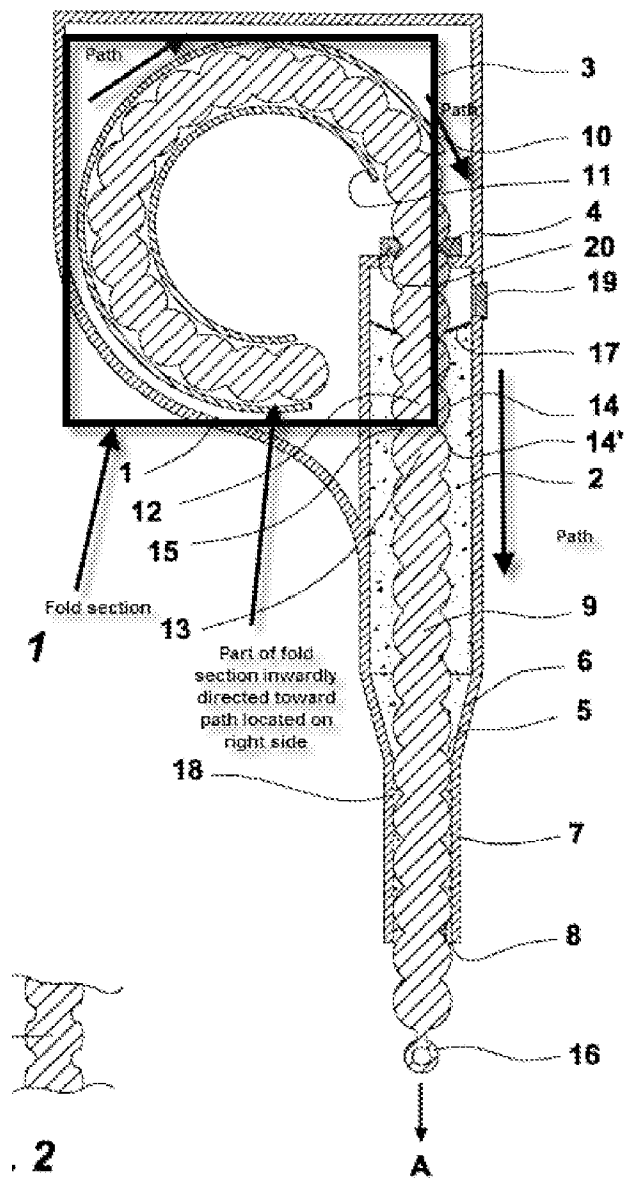
As to claim 1, *Ewerlog* discloses a track (9, Figure 1) adapted for use in a hand-held, capsule containing device (Page 1, Lines 6-9) which is adapted to receive a series of capsules therein (Page 2, Lines 30-33) and defines a conveying path along which the capsules are conveyable (Page 9, Lines 21-31), wherein the path includes at least one fold section (rolled up position between guide rails 10,11) thereby to provide the path with a space-saving configuration.



As to claim 2, wherein the path is an endless path (see Figure above).

As to claim 3, wherein the at least one fold section is inwardly directed (see Figure above).

As to claim 4, wherein the at least fold section is inwardly directed towards another section of the path (see Figure below).



As to claim 5, a track wherein the at least one fold section is a loop section in the path (see Figure above).

As to claim 6, wherein the loop section is an inverted, generally U-shaped section (see Figure above).

As to claim 9, a track adapted to receive the capsules in a chain configuration (Page 7, Lines 30-34, Page 8, Lines 1-3).

As to claim 11, a hand-held device (Page 10, Lines 9-19) for conveying capsules therein having a track according to claim 1 (see Figure above).

As to claim 12, further having a plurality of capsules in the track (Page 2, Lines 24-33).

As to claim 13, in which the capsules are in a chain configuration in the track (see Figure above).

As to claim 14, in which the capsules are in an endless chain in the track (see Figure above).

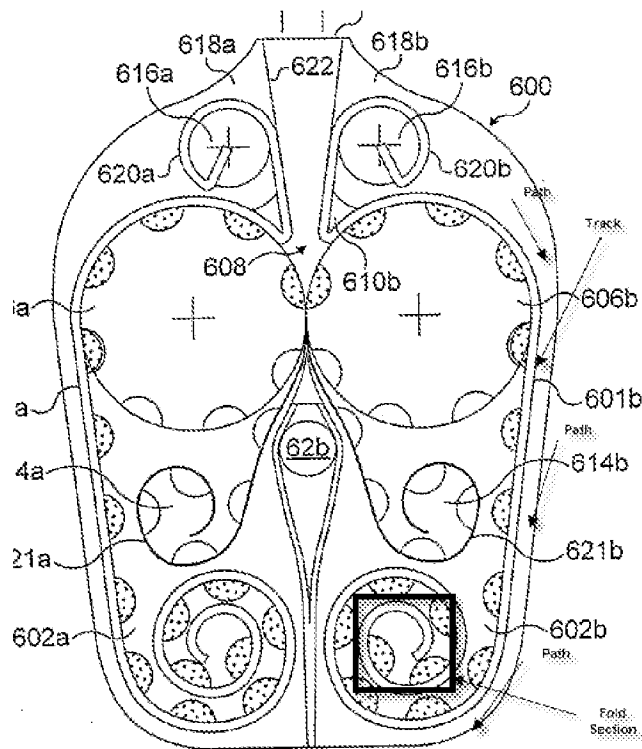
As to claim 15, in which the capsules are linked together to form the chain (see Figure above).

8. Claims 1-3, 5-13, 15-16, 18-22, and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 03/061743 A1 to *Anderson et al.*

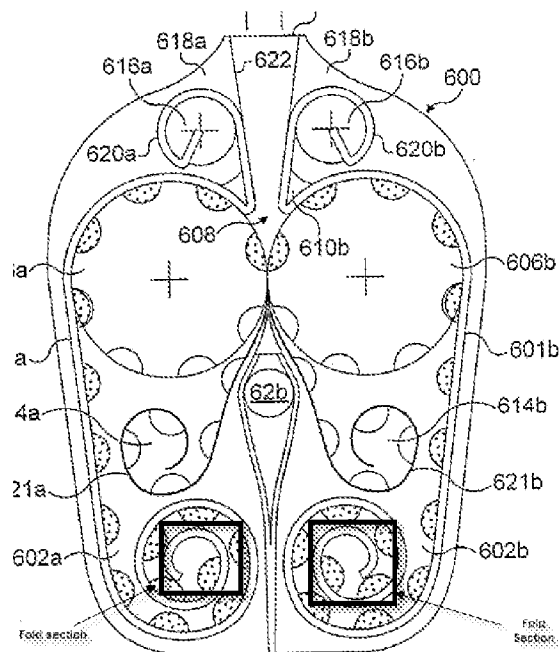
As to claim 1, *Anderson* discloses a track (102, Figure 1) adapted for use in a hand-held, capsule containing device which is adapted to receive a series of capsules therein (Page 41, Lines 18-27) and defines a conveying path along which the capsules are conveyable (Figure 6A, track represented by 601a and 601b which is same as 102, Page 46, Lines 1-7), wherein the path includes at least one fold section thereby to provide the path with a space-saving configuration (fold section represented by

Art Unit: 4138

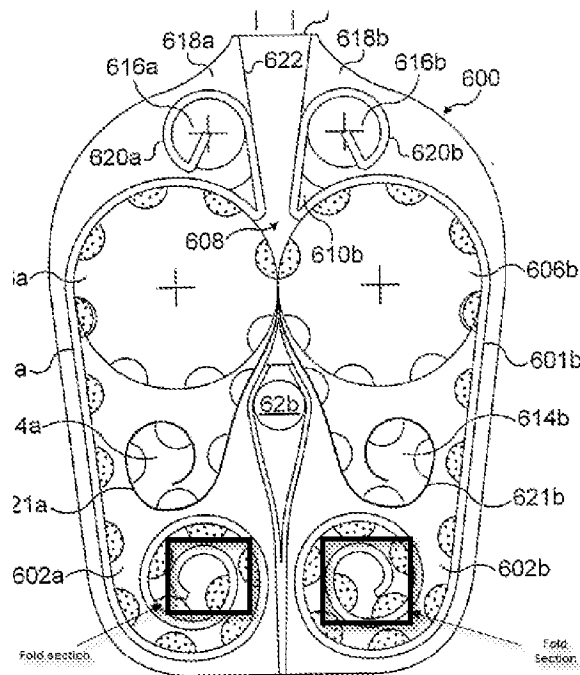
curved path seen in the lower part of the left chamber 602a and right chamber 602b).



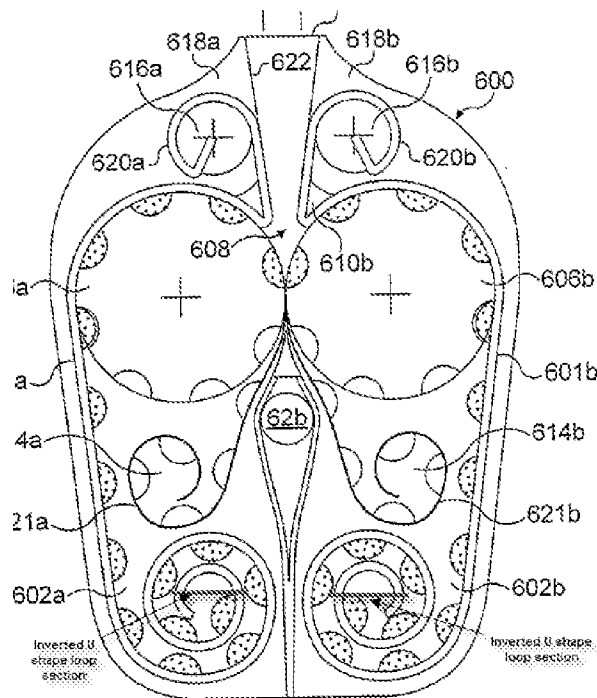
As to claim 3, a track wherein the at least one fold section is inwardly directed (represented by track 601a and 601b that in the lower part of the left chamber 602a and right chamber 602b).



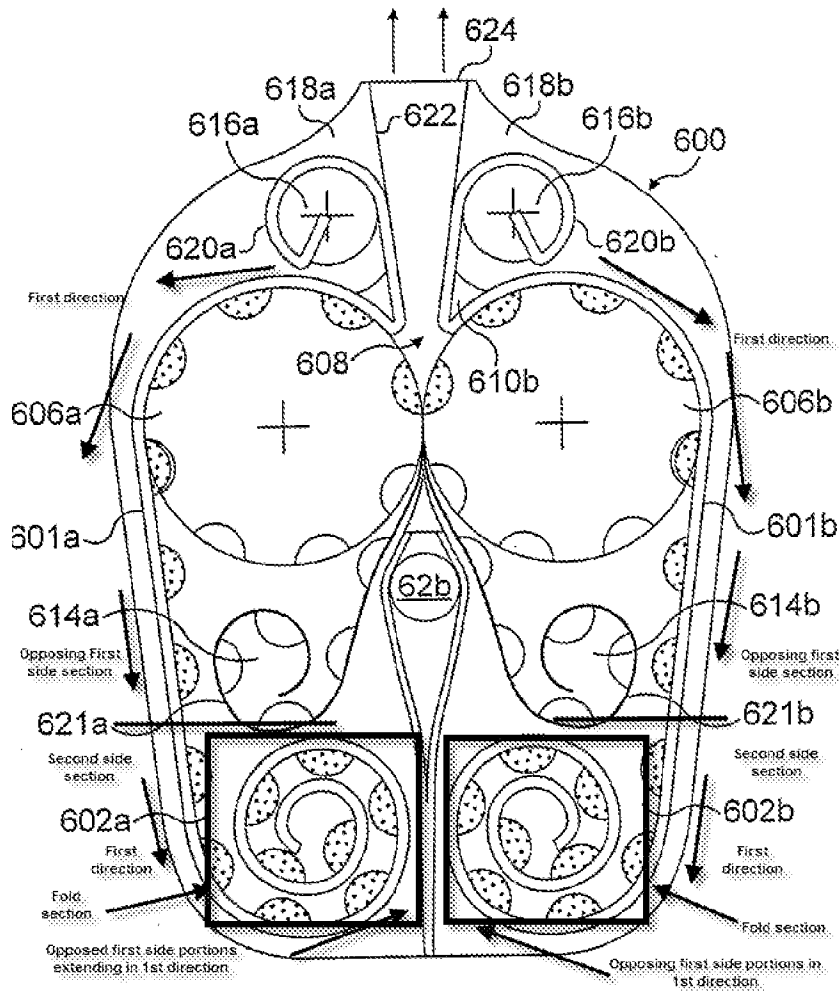
As to claim 5, a track wherein the at least one fold section is a loop section in the path (Figure 6a, fold section seen in the lower part of the left chamber 602a and right chamber 602b has a loop section).



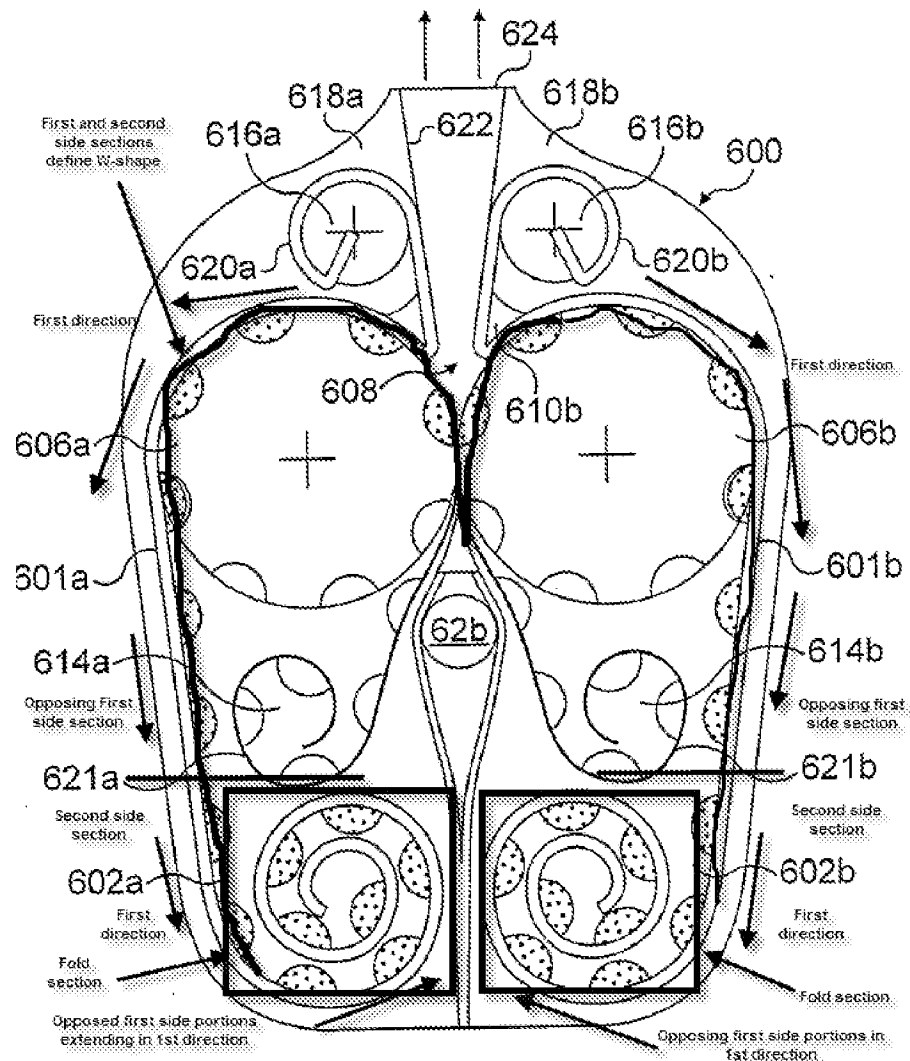
As to claim 6, wherein the loop section is an inverted, generally U-shaped section (see Figure below).



As to claim 7, wherein the path has a pair of opposed side sections extending from first ends thereof generally in a first direction and a second side section extending generally transversely to the first direction to connect the respective first ends of the first side sections wherein the at least one fold section is in the second side section and has a pair of opposed first side portions which extend generally in the first direction, the at least one fold section being directed such that each first side portion is in facing relation with a different first side portion (see Figure below).



As to claim 8, wherein the first and second side sections define a generally W-shape when viewed in plan.



As to claim 9, a track adapted to receive the capsules in a chain configuration (Figure 6A, Page 46, Lines 14-19).

As claim 10, a track adapted to receive and to enable conveying of elongate capsules oriented upright in the track (Page 3, Lines 21-22; Page 6, Lines 4-9). In regards to the track adapted to enable conveying of elongate capsules oriented upright in the track, it has been held that the

recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

As to claim 11, a hand-held device (600, Figure 6A, Page 46, Lines 1-2, Page 2, Lines 1-6) for conveying capsules therein having a track (Figure 6A, 601a & 601b) according to claim 1 (Page 46, Lines 2-9).

As to claim 12, further having a plurality of capsules in the track (Page 41, Lines 18-27). In regards to this claim, although the reference numbers are different in Figure 1, they represent the same components as represented in Figure 6A.

As to claim 13, the capsules are in a chain configuration in the track (Figure 6A).

As to claim 15, the capsules are linked together to form the chain (Figure 1, Page 41, Lines 1-18-27). Since the capsules are linked together via the track, upon placing the track into the handheld device, a chain is formed. Furthermore, in regards to this claim, although the reference numbers are different in Figure 1, they represent the same components as represented in Figure 6A.

As to claim 16, the capsules are of elongate form and disposed upright in the track (Page 3, Lines 21-22; Page 6, Lines 4-9). Since the

track within the handheld device can hold capsules of different sizes (Page 41, Lines 24-27), it is capable of being disposed upright in the track.

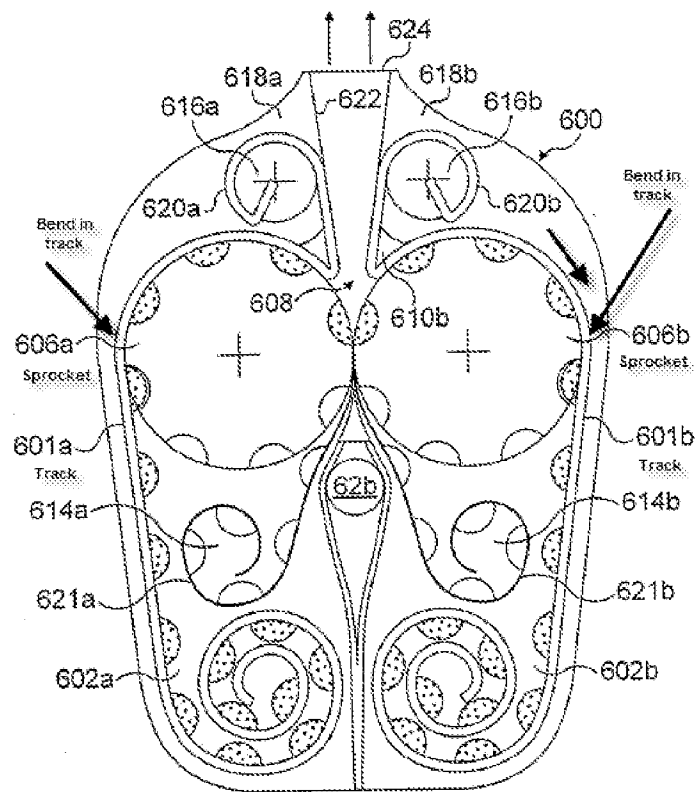
As to claim 18, the capsules contain a powder (Page 41, Lines 19-21). Furthermore, in regards to this claim, although the reference numbers are different in Figure 1, they represent the same components as represented in Figure 6A.

As to claim 19, the capsules contain a medicament (Page 41, Lines 19-24). Furthermore, in regards to this claim, although the reference numbers are different in Figure 1, they represent the same components as represented in Figure 6A.

As to claim 20, further having a conveying mechanism for conveying the capsules about the track (Page 46, Lines 4-7).

As to claim 21, in which the conveying mechanism comprises at least one sprocket (Figure 6, 606a,606b) for driving the capsules (Page 17, Lines 16-24).

As to claim 22, wherein the at least one sprocket is located at a bend in the track for engaging the capsules for advancement thereof along the track (Figure 6, 606a,606b) (See below).



As to claim 24, a hand-held device according to claim 11 adapted for use as a component part of an inhalation device for delivering medicament to a patient (Page 41, Lines 18-24). Furthermore, in regards to this claim, although the reference numbers are different in Figure 1, they represent the same components as represented in Figure 6A.

As to claim 25, an inhalation device for delivering medicament to a patient incorporating a hand-held device according to claim 11 (Page 2, Lines 11-16).

9. Claims 1, 11, 12, 17, and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No 3,558,003 to *Jones et al.*

As to claim 1, Jones discloses a track (4a, Figures 7 & 8) adapted for use in a hand-held, capsule containing device which is adapted to receive a series of capsules therein (Column 1, Lines 39-41) and defines a conveying path along which the capsules are conveyable (Column 2, Lines 15-20), wherein the path includes at least one fold section thereby to provide the path with a space-saving configuration (fold section represented by curved path seen in Figure 7 and 8).

As to claim 11, a hand-held device (1) for conveying capsules therein having a track (4a) according to claim 1 (Column 1, Lines 39-44).

As to claim 12, further having a plurality of capsules in the track (Figure 8).

As to claim 17, in which the capsules are generally of cylindrical form (Figure 8).

As to claim 20, a hand-held device according to claim 11 further having a conveying mechanism for conveying the capsules about the track (Column 2, Lines 3-14).

As to claim 21, a hand-held device according to claim 20 in which the conveying mechanism comprises at least one sprocket (14a, Figure 8) for driving the capsules (Column 2, Lines 3-14).

As to claim 22, a hand-held device according to claim 21, wherein the at least one sprocket is located at a bend in the track for engaging the capsules for advancement thereof along the track (Figure 7 and 8).

As to claim 23, a hand-held device according to claim 21, wherein the sprocket is located at the fold section (Figure 7 and 8).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CELENE MOORER whose telephone number is (571)270-7411. The examiner can normally be reached on M-F 7:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on (571)272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. M./
Examiner, Art Unit 4138

/Melba Bumgarner/
Supervisory Patent Examiner
Art Unit 4138